

REMARKS

Applicants noted with appreciation that the rejections under 35 U.S.C. § 103(a) are withdrawn.

Claims 1-8 are pending and under consideration.

I. NONSTATUTORY DOUBLE PATENTING

Claims 1-8 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of co-pending application Serial No. 10/699,117 (hereinafter, the '117 application) in view of Huang *et al.* (U.S. Patent No. 4,966,934 hereinafter, the '934 patent). In particular, the Examiner alleges that it would have been obvious to one skilled in the art at the time of the invention to substitute a photoinitiation system and to add HEMA, as taught by Huang *et al.*, in the compositions claimed in the '117 application with an expectation of providing a fast curing dental adhesive composition in a one component system. This rejection is traversed. Reconsideration is respectfully requested.

The '117 application claims priority to the Korean Patent Application No. 10-2003-60180, filed August 29, 2003 as evident from the cover sheet of the US Publication No. 2005/0049326 A1. The instant application claims priority of March 4, 2003, as shown on the certified copy of the priority document submitted to the United States Patent and Trademark Office on October 31, 2003. Thus, the priority date of the instant application precedes the priority date of the '117 application. Accordingly, the '117 application cannot serve as a prior art in determining the patentability of the present application, thus the Examiner's combination of references is improper.

With regard to the '934 patent, its disclosure is irrelevant if viewed alone. The '934 patent teaches an adhesive composition comprising a polymerizable monomer, bis-GMA, a photoinitiating system and hydroxyethyl methacrylate (HEMA). Although the intended purpose of the composition taught by the '934 patent is the same as of that instantly claimed, the claimed composition comprises different ingredients, in particular, it lacks HEMA, and, as such, is distinct from that taught by the '934 patent. As claims 1-8 of the '934 patent are patentably distinct from those of the instant application, they do not render the instant claims obvious.

Therefore, Applicants respectfully request that the rejection of claims 1-8 as unpatentable over the '117 application in view of Huang *et al.* be withdrawn.

CONCLUSION

In light of the above remarks, Applicants respectfully submit that claims 1-8 satisfy all the criteria for patentability and are in condition for allowance. An early indication thereof is kindly solicited.

No fees are believed to be due. However, the Commissioner is hereby authorized to charge any required fee(s) to Jones Day Deposit Account No. 50-3013 (referencing Attorney Docket No. 8111-034-999).

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Respectfully submitted,



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